# IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hisashi SAKAKIBARA

Serial No. 09/632,586          Group Art Unit: 2177

Confirmation No. 1897

Filed: August 4, 2000          Examiner: S. T. Channavajjala

For:    POINT MANAGING METHOD, POINT MANAGING SYSTEM, CENTRAL UNIT AND RECORDING MEDIUM

## AFTER-FINAL AMENDMENT

**RECEIVED**

NOV 0 3 2003

Technology Center 2100

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Attention: **BOX AF**

Sir:

This is in response to the Office Action mailed July 28, 2003, and having a period for response set to expire on October 28, 2003.

Reconsideration of the claims is respectfully requested. The following remarks are respectfully submitted.

**IN THE CLAIMS:**

The text of all pending claims are set forth below. Cancelled and withdrawn claims are indicated with claim number and status only. The claims as listed below show added text with underlining and deleted text with ~~strikethrough~~. The status of each claim is indicated with one of (original), (currently amended), (previously amended), (cancelled), (withdrawn), (new), (previously added), (reinstated - formerly claim #), (previously reinstated), (re-presented - formerly dependent claim #) or, (previously re-presented).

Please AMEND the claims in accordance with the following:

1. (CURRENTLY AMENDED) A point managing method for managing points among a first business entity, ~~a~~ plural second business ~~entity~~ entities each of which has a business arrangement ~~who cooperates~~ with said first business entity, and ~~and~~ customers of the first and second business entities, said first business entity managing communication points that are capable of being exchanged by customers ~~used~~ for on-line obtaining of goods or services, said second business ~~entity~~ entities managing ~~valuable~~ value points given to customers as a reward for consumption activity, where the second business entities have already given value points to a customer as part of transactions completed before the customer uses said method, said method comprising ~~the steps of~~:

interactively instructing said first business entity ~~by said customer~~ to exchange ~~valuable~~ value points for communication points, where the customer does the instructing;

responsive to and in accordance with the instructing, automatically requesting said second business entity ~~by said first business entity~~ to send ~~valuable~~ the value points already given to the customer ~~according to the instruction~~;

responsive to the requesting, automatically sending the requested already given value ~~valuable~~ points from ~~by~~ said second business entity to said first business entity; and

responsive to receiving the value points, exchanging the received ~~valuable~~ value points of each said second business entity for communication points ~~by said first business entity~~, according to ~~a preset~~ preset exchange rates, each corresponding to a respective second

business entity, whereby the exchanged-for communication points become available to the customer for on-line obtaining of goods or services via the first business entity.

3.
~~2.~~    (CURRENTLY AMENDED) A point managing system comprising a central unit for managing communication points used for obtaining on-line services, a cooperate-use terminal unit that is connected to said central unit and manages ~~valuable~~ value points of plural second business entities representing ~~a~~ an already-given reward for prior consumption activity with the same, and a customer-use terminal unit that is connected to said central unit, wherein

said customer-use terminal unit comprises a controller capable of performing the operation of transmitting to said central unit exchange instructing information instructing an exchange of ~~valuable~~ value points for communication points,

said central unit comprises:

a communication point database that records information related to communication points;

an exchange database that records information ~~related to~~ of an exchange rate between communication points and ~~valuable~~ value points for each second business entity; and

a controller capable of performing the operation of transmitting to said cooperate-use terminal unit ~~valuable~~ value point request information requesting ~~valuable~~ value points corresponding to the customer-use terminal unit according to received exchange instructing information; and

said cooperate-use terminal unit comprises:

a ~~valuable~~ value point database that records information ~~related to valuable~~ of value points;

a controller capable of performing ~~the following~~ operations comprising:

transmitting to said central unit ~~valuable~~ value points;

corresponding to received ~~valuable~~ value point request information; and

updating the ~~valuable~~ value point database according to the transmitted ~~valuable~~ value points; and

said controller of the central unit further capable of performing ~~following~~ operations comprising:

exchanging received ~~valuable~~ value points for communication points of a first

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business entity according to an exchange rate recorded in said exchange database where the exchange rate corresponds to a second business entity that previously issued the exchanging value points; and

updating said communication point database according to the exchanged communication points, whereby the exchanged-for communication points become available to the customer for on-line obtaining of goods or services via the first business entity..

3. (CURRENTLY AMENDED) The point managing system as set forth in claim 1, wherein

said controller of the customer-use terminal unit further capable of performing following operations:

accepting input of first identification information related to customers and second identification information that is different from said first identification information; and

transmitting said first and second identification information to said central unit;

said controller of the central unit further capable of performing the following operations:

authenticating said customer-use terminal unit based on received first identification information; and

transmitting received second identification information to said cooperate-use terminal unit;

said valuable value point database provided in said cooperate-use terminal unit stores valuable value points recorded to correspond to the second identification information; and

said controller of the cooperate-use terminal unit further capable of performing the operation of extracting from the valuable value point database valuable value points to be transmitted to said central unit, according to received second identification information.

4. (CURRENTLY AMENDED) A central unit connected to a cooperate-use terminal unit for managing valuable value points of plural second business entities representing a an already-given reward for prior consumption activity with the same, and a customer-use terminal unit, for managing communication points used for on-line services, comprising:

a communication point database that records information related to communication points;

an exchange database that records information ~~related to~~ of an exchange rate between communication points and ~~valuable~~ value points for each second business entity; and

a controller, coupled to said communication point database and said exchange database, and capable of performing ~~the following~~ operations comprising:

when exchange instructing information instructing an exchange of ~~valuable~~ value points for communication points is received, for transmitting to said cooperate-use terminal unit ~~valuable~~ value point request information requesting ~~valuable~~ value points corresponding to the customer-use terminal unit according to the received exchange instructing information;

when ~~valuable~~ value points corresponding to the transmitted ~~valuable~~ value point information are received, for exchanging the received ~~valuable~~ value points for communication points of a first business entity according to an exchange rate recorded in said exchange database where the exchange rate corresponds to a second business entity that previously issued the exchanging value points; and

updating said communication point database according to the exchanged communication points whereby the exchanged-for communication points become available to the customer for on-line obtaining of goods or services via the first business entity.

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5. (CURRENTLY AMENDED) A computer readable recording medium including thereon a recorded computer program for causing a computer having communication means to manage communication points used for on-line services, comprising:

computer readable program code ~~means~~, when receiving exchange instructing information instructing an exchange of ~~valuable~~ value points of plural second business entities representing ~~a~~ an already-given reward for consumption activity with the same for communication points ~~is received~~, ~~for~~ causing a computer to transmit ~~valuable~~ point request information requesting ~~valuable~~ value points to said communication means corresponding to the requested ~~valuable~~ value points, according to said exchange instructing information; and

computer readable program code ~~means~~, when ~~valuable~~ value points corresponding to the transmitted ~~valuable~~ value point request information are received, ~~for~~ causing a computer to exchange the received ~~valuable~~ value points for communication points according to a preset exchange rate, where the exchange rate corresponds to a second business entity that previously issued the exchanging value points, and whereby the exchanged-for communication points

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become available to the customer for on-line obtaining of goods or services via the first business entity.

6.   (CURRENTLY AMENDED) A method of exchanging points between different business entities, comprising:

responsive to a customer purchasing a good or service goods or services from a-first business entity entities that offers offer various types of goods or services, automatically crediting to the customer non-monetary first points of a type types issued by the first business entity entities, where the first business entity agrees entities agree to, upon conditions, redeem to the customer the credited non-monetary first points in exchange for any of the goods or services of the various types offered by the first business entity entities; and

after crediting the first points, in response to an interactive request of the customer, exchanging the credited non-monetary first points for non-monetary second points of a type issued by a second business entity which are credited to the customer, where the second business entity agrees to, upon conditions, redeem to the customer the credited non-monetary second points in exchange for any of goods or services of various types offered by the second business entity, where the first points and the second points are of types that are not fungible.

7.   (PREVIOUSLY PRESENTED) A method according to claim 6, wherein the exchanging further comprises de-crediting the first points from the customer.

8.   (CURRENTLY AMENDED) A method according to claim 6, wherein each first business entity has an exchange rate, and wherein the first points and second points are exchanged according to electronic exchange rate information of a first business entity who issued the first points being exchanged.

9.   (PREVIOUSLY PRESENTED) A method according to claim 6, wherein the first points are only directly redeemable by the first business entity, and wherein the second points are only directly redeemable by the second business entity.

2 10.   (NEW) A method according to claim 1, wherein the business arrangement of

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each second business entity comprises a contract between such second business entity and the first business entity, wherein the contract is for exchanging value points for communication points.

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## REMARKS

### INTRODUCTION

Claims 1-9 were previously pending and under consideration.

Claim 10 is added herein.

Therefore, claims 1-10 are now pending and under consideration.

Claims 1-9 are rejected.

Claims 1-6 and 8 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

### ENTRY OF AMENDMENT UNDER 37 CFR § 1.116

Applicant requests entry of this Rule 116 Response because:

(a) it is believed that the amendment of the claims puts this application into condition for allowance;

(b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed; and

(c) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance <u>or in better form for appeal</u> may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

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## INTERVIEW

Applicant thanks the Examiner for the Interview of September 5, 2003. The Applicant discussed the use of value and communication points as a form of value exchange and related features such as an exchange rate for exchanging value points for communication points. The Examiner indicated difficulty interrelating some elements of the claims. The Applicant also discussed that the division of credit points among relatives or relations of a cardholder is not the same as exchanging points between different business entities according to an exchange rate. The Examiner indicated that he would reconsider his opinion pending further clarification of the claims.

## REJECTIONS UNDER 35 USC § 103

In the Office Action, at pages 3-8, claims 1-5 were rejected under 35 U.S.C. § 103 as being obvious over Horstmann in view of Walker. In the Office Action, at pages 9-13, claims 6-9 were rejected under 35 U.S.C. § 103 as being obvious over Horstmann in view of Ng. These rejections are traversed and reconsideration is requested.

In one aspect of the present invention, a plurality of businesses (second business entities) issue value points, for example as a reward for doing business. A customer receives some of the value points from a value-point issuing second business entity as part of a transaction with one of these businesses. The value points each second entity issues to the customer are exchanged for another type of point - communication points. The exchange is done according to a preset exchange rate of each second business entity. The communication points may be used for online transactions via the first business entity. This allows the customer, if they wish, to consolidate their previously obtained points (value points) from multiple businesses and then use their value to deal with an online business (first business entity) to exchange the consolidated value (which is now in the form of communication points). The prior art combination does not discuss this set of related features, which are discussed further below.

For the purpose of discussion, it is noted that in the term "*value* point" generally indicates a measure of value. The term "*communication* point" also indicates a measure of value, however the term "communication" reflects that the value may be used online and can be a

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measure of common or consolidated value. It is also noted that the first/second nomenclature in claims 1-5 is reversed in claims 6-9, which refer to the multiple business entities that issued the prior points as the "first" business entities, and which refer to the other business that exchanges the points as the "second" business entity.

The claims recite various distinct and different business entities. There are a plurality of different business entities (second entities in claims 1-5, first entities in claims 6-9), and there is an exchanging business entity (first entity in claims 1-5, and second entity in claims 6-9). It is respectfully submitted that the objects discussed in Horstmann are not business entities, but rather they are objects representing the same. A computer programming object is not a real world business entity, such as a corporation, institution, etc. The abstract object representations of business entities in Horstmann are only a tool for object-oriented business programming. There is no suggestion in Horstmann that the abstract businesses A, B, and C interact in the manner recited in the present claims. The addition of Walker only results in a system where a single business entity issuing points can be efficiently represented with an object on a network. There is no discussion or suggestion in Horstmann or Walker that the objects should be provided with the multi-entity features of the present claims.

Horstmann is cited for providing technology to enable implementation of the business features of Walker. Walker is cited as providing the non-technical business features recited in the claims. Therefore, the following non-technical business distinctions over Walker distinguish over the combined prior art.

Claim 1, for example, recites that a customer has value points that were given before the exchange of the value points for the communication points. Only Walker has been cited as providing this feature. However, in Walker there is only one type of point and it is distributed at the time of issuance among people associated with a credit account at the time of transaction. Therefore, there is no exchange of already-given points (value points) of one business (a second business entity) for communication points. Furthermore, Walker does not discuss a rate for exchanging one type of point (value points) for another type of point (communication points), where the value points are of different business entities that have a business arrangement. The only discussion of disposition of points in Walker is the post-transaction trade-in of value points for a good or service of the same business that issued the value point (i.e. trading in the points).

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In sum, Walker only discusses one business rewarding one set of customers for a purchase. There is no discussion of how the customers consolidate their value points already given by multiple different businesses using a common or communication point of a different (first) business that was received in exchange for the value points of other (second) businesses.

It is also submitted that even if, for the sake of discussion, Walker is assumed to discuss multiple second business entities, there is no discussion in Walker that the points of the second business entities are each exchanged according to their own rate of exchange with respect to communication points (e.g. "exchanging the received value points of each said second business entity for communication points according to **preset exchange rates, each corresponding to a respective second business entity**"). That is to say, Walker does not discuss an exchange rate of each second business.

Finally, if the Walker reference is maintained, in order to facilitate prosecution of this application, Applicant respectfully requests the Examiner to specifically identify what in Walker corresponds to each of the value points, the communication points, the plural second business entities, the first business entity, and the exchange rate of each respective second business entity.

## DEPENDENT CLAIMS

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 10 recites "the business arrangement of each second business entity comprises a contract between such second business entity and the first business entity, wherein the contract is for exchanging value points for communication points". The prior art does not discuss this form of arrangement between distinct business entities. This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance.  An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: _28 OCT 2003_

By: _____
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## REPLY/AMENDMENT FEE TRANSMITTAL

| | |
|---|---|
| Attorney Docket No. | 1536.1002 |
| Application Number | 09/632,586 |
| Filing Date | August 4, 2000 |
| First Named Inventor | Hisashi SAKAKIBARA |
| Group Art Unit | 2177 |

| | | | |
|---|---|---|---|
| AMOUNT ENCLOSED | | Examiner Name | S. T. Channavajjala |

### FEE CALCULATION (fees effective 10/01/03)

| CLAIMS AS AMENDED | Claims Remaining After Amendment | Highest Number Previously Paid For | Number Extra | Rate | Calculations |
|---|---|---|---|---|---|
| TOTAL CLAIMS | 10 | - 20 = | 0 | X $ 18.00 = | $ 0.00 |
| INDEPENDENT CLAIMS | 5 | - 5 = | 0 | X $ 86.00 = | 0.00 |

| | |
|---|---|
| Since an Official Action set an _original_ due date of _October 28, 2003_, petition is hereby made for an extension to cover the date this reply is filed for which the requisite fee is enclosed (1 month ($110); 2 months ($420); 3 months ($950); 4 months ($1,480); 5 months ($2,010)): | |
| If Notice of Appeal is enclosed, add ($320.00) | |
| If Statutory Disclaimer under Rule 20(d) is enclosed, add fee ($110.00) | |
| Information Disclosure Statement (Rule 1.17(p)) ($180.00) | |
| Total of above Calculations = | $ 0.00 |
| Reduction by 50% for filing by small entity (37 CFR 1.9, 1.27 & 1.28) | |
| TOTAL FEES DUE = | $ 0.00 |

(1) If entry (1) is less than entry (2), entry (3) is "0".
(2) If entry (2) is less than 20, change entry (2) to "20".
(4) If entry (4) is less than entry (5), entry (6) is "0".
(5) If entry (5) is less than 3, change entry (5) to "3".

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### METHOD OF PAYMENT

☐ Check enclosed as payment.

☐ Charge "TOTAL FEES DUE" to the Deposit Account No. below.

☒ No payment is enclosed and no charges to the Deposit Account are authorized at this time (unless specifically required to obtain a filing date).

### GENERAL AUTHORIZATION

☒ If the above-noted "AMOUNT ENCLOSED" is not correct, the Commissioner is hereby authorized to credit any overpayment or charge any additional fees necessary to:

| Deposit Account No. | 19-3935 |
|---|---|
| Deposit Account Name | STAAS & HALSEY LLP |

☒ The Commissioner is also authorized to credit any overpayments or charge any additional fees required under 37 CFR 1.16 (filing fees) or 37 CFR 1.17 (processing fees) during the prosecution of this application, including any related application(s) claiming benefit hereof pursuant to 35 USC § 120 (e.g., continuations/divisionals/CIPs under 37 CFR 1.53(b) and/or continuations/divisionals/CPAs under 37 CFR 1.53(d)) to maintain pendency hereof or of any such related application.

SUBMITTED BY: STAAS & HALSEY LLP

| Typed Name | James T. Strom | | Reg. No. | 48,702 |
|---|---|---|---|---|
| Signature | | | Date | 28 OCT 2003 |

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